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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/960,419	09/21/2001	Shoji Ikeda	0941.65839	5534

7590 04/05/2004

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EXAMINER

RESAN, STEVAN A

ART UNIT PAPER NUMBER

1773

DATE MAILED: 04/05/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/960,419	IKEDA ET AL.	
	Examiner	Art Unit	
	Stevan A. Resan	1773	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 January 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input checked="" type="checkbox"/> Other: <u>See Continuation Sheet</u> . |

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1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 14 January 2004 has been entered.

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-20 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Shigehiro et al JP 10-270246.

Shigehiro et al disclose a soft magnetic film comprising Fe, Co, an element M and Oxygen falling overlapping the ranges of applicants claim 1 formula and having the

claimed BCC phase and crystal grain size of less than 50 nm. See Shigehiro et al [008],[009],[0010],[0017],[0029],[0030].

Also note the table on page 6 which shows examples with a Co content of .55-.63 in the range of claimed "a"=0.5-0.65, (Co + Fe) content of .85-.87 in the range of claimed "x" when claimed "y + z" is less than 15%, Al of 4-9% in the claimed range of "y"=0.2-9%, and oxygen of 10-22% in the claimed range of "z"=1-12%.

Shigehiro et al teach that "M" as claimed may be an alloy composed of at least two elements ([009]) as in claims 2, 20; that uniaxial magnetic anisotropy is formed having a anisotropic microstructure with a major axis shorter than 50 nm ([0017],[0022]) as in claims 3,4,7,8-14; that the electrical resistivity may overlap the claimed range of less than 50 $\mu\Omega\text{cm}$ (Compare the present specification figure 3 with figure 5 page 10 of Shigehiro et al.) as in claims 15,16; that the film may comprise another magnetic film forming a composite structure (Example 4 [0034] ,[0036]) multilayers are formed which reduce eddy current loss when used as a core material for a magnetic head as in claim 19 (See also [005]).

While Shigehiro et al do not disclose the property as in claims 5 and 6 since the composition and structure are in the same range they would be expected to have the same properties. Furthermore it would have been obvious to one of ordinary skill in the art to lower coercivity since the film would be part of a magnetic head.

If the chemical composition of the claimed article of manufacture recited in the claims is the same as the identical structure of the prior art, it is immaterial that the applicant recognized different advantages flowing therefrom than did the prior art. Ex

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parte Tummers et al. (POBA 1962) 137 USPQ 44, or that a claim thereto recites a property thereof not disclosed in the prior art. Titanium Metals Corp. of America v. Banner (CAFC 1985) 778 F.2d 775, 227 USPQ 775.

The claiming of a previously unidentified property that is inherently present does not necessarily make a claim patentable.

It has been held that where claimed and prior art products are identical or substantially identical in structure or in composition, or are produced by identical or substantially identical processes a case of anticipation or a prima facie case of obviousness has been established and the burden of proof is shifted to applicant to show that prior art products do not necessarily or inherently possess the characteristic of a claimed product whether the rejection is based upon "inherency" under 35 USC 102 or on "prima facie obviousness" under 35 USC 103 jointly or alternately. In re Best 562 F.2d 1252, 1255, 195 USPQ 430, 433 (CCPA 1977); In re Ludke, 58 CCPA 1159, 441 F.2d at 212-13, 169 USPQ 563 (1971); In re Brown, 59 CCPA 1036, 459 F.2d 531, 173 USPQ 685 (1972).

"When the PTO shows a sound basis for believing that the products of the applicant and the prior art are the same, the applicant has the burden of showing that they are not". In re Spada. 911 F.2d 705, 709, 15 USPQ 2d 1655 (Fed. Cir. 1990).

5. Applicant's arguments filed 14 January 2004 as they apply to Shigehiro et al have been fully considered but they are not persuasive.


Applicants continue to assert that Shigehiro et al does not overlap the presently claimed range. However this is clearly not the case as pointed out above by reference to specific compositions of Shigehiro et al..

Applicants Figure B is clearly wrong as they have grouped Fe with Co as defining x while Shigehiro et al only define the content of **Fe alone as x.** Thus while $15 < x + y + z < 65$, Co may range up to 85 and thus (Co + Fe) may range up to 92 since the minimum for y + z is less than 8. Applicants attention is particularly drawn to page 10 figures 5 and 6 clearly showing y + z falling in this range.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stevan A. Resan whose telephone number is 571-272-1513. The examiner can normally be reached on Tues-Thurs from 7:30 AM to 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paul Thibodeau, can be reached at 571-272-1516. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


STEVAN A. RESAN
PRIMARY EXAMINER

Continuation of Attachment(s) 6). Other: machine translation JP 10-270246.